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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,948	11/24/2003	Paul R. Gagnon	03-482	5271

34704 7590 10/03/2006

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EXAMINER
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ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/720,948

Applicant(s)

GAGNON, PAUL R.

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/24/06 by the Board of Patent Appeals.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

  
MITRA ARYANPOUR  
PRIMARY EXAMINER

### DETAILED ACTION

In view of the decision of the Board of Patent Appeals and Interferences dated 24 August 2006, a new ground(s) of rejection follows.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 3-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan et al (4,951,658).

Regarding claim 1, Morgan's eye patch is an occlusive, opaque patch that forces a patient to use his weak or lazy eye. (see column 1, lines 8-10; and column 4, lines 14-16). The patch is placed over the good eye to completely block the vision of the user in that eye. (see column 1, lines 8-10, 57-60). Because the patch is "occlusive" and "opaque" and is meant to block the vision of the user, the patch necessarily must have a thickness sufficient to perform the vision-blocking function as claimed in claim 1. Morgan also teaches using an adhesive to attach the eye patch to the user. (see column 2, lines 18-21). Moreover, because Morgan's patch is placed over an eye, it is placed on a portion of the face of an individual wearing the patch. Claim 1 does not prohibit a complete blocking of an individual's vision using the device. Additionally, it is noted that the specification states that in some cases the device will "completely" restrict the individual's field of vision with regard to the sports object being controlled. (see specification, page 1, ¶ [0001]). This teaching reflects that it is reasonable and consistent with the specification

Art Unit: 3711

to interpret claim 1 as encompassing a device which completely blocks the user's vision. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Regarding claims 3-5 and 9, Morgan teaches constructing the patch using open-cell foam (claim 3) with a hydrocolloidal adhesive backing material (claim 5). (see column 2, lines 29-40). The adhesive and open-cell foam wick moisture away from the user and through the foam material for evaporation from the surface of the patch (claim 4). (see column 2, lines 29-40, and column 4, lines 33-43). With regards to the device being disposal, because Morgan's eye patch, as with any object, is inherently capable of being thrown away (i.e. "disposable"), therefore, meets the claimed limitation.

Regarding claims 7 and 8, Generally, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the substrate, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (C.C.P.A. 1969); MPEP § 2112.01 (Rev. 3, August 2005). Additionally, matters directed to design or ornamentation only, having no mechanical function whatsoever with respect to the claimed invention, cannot be relied on as a basis for patentability. In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (C.C.P.A. 1947). Therefore, in order for the "logo" and "written indicia" recited in claims 7 and 8 to distinguish the product from the prior art, there must be a functional relationship between the "logo" or "written indicia" and the substrate of the sports vision-training device. Mere ornamentation of the product will not impart patentability to an otherwise old product. Applying this legal principle to claims 7 and 8, it appears that the "logo"

Art Unit: 3711

and "written indicia" limitations are mere ornamentation and are not functionally related to the substrate. Applicant has disclosed nothing in his specification to indicate that the "logo" or "written indicia" serves any function other than ornamentation. As such, the "logo" and "written indicia" may not be relied upon for patentability.

**Additionally:**

3. Claims 1, 2, 7-10, 15, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (6,320,094).

Regarding claims 1 and 10, Arnold teaches an eye patch that anticipates claims 1 and 10. (see column 1, lines 7-10). Arnold teaches applying the disposable eye patch to the user's face with an adhesive layer. (see column 1, lines 7-10, Column 3, lines 34-39). Arnold's patch has a sufficient "thickness" to satisfy the claimed vision-interfering functions of independent claims 1 and 10 i.e. Arnold's patch placed over the eye of a user would interfere with the user's "ability to look at said sporting object while attempting to control said sporting object due to said thickness" for the reasons explained earlier. Arnold teaches that her eye patch has first and second sheet members (11 and 12, respectively) having a thickness ranging from 0.1 mm to 5 mm (.004 to .196 inches). (see column 3, lines 39-45). As shown in Arnold's figure 3, the first and second sheets are positioned atop one another with an adhesive (13a) dispersed between them. Arnold also teaches that the first and second sheet members preferably have the same thickness. (see column 2, lines 18-19). Summing the thicknesses gives an eye patch thickness range of 0.2 to 10 mm (.008 to .292 inches). Actually, as shown in figure 3, Arnold's patch thickness will be thicker than this summed range, because of the additional thickness included by the adhesive layer 13a.

Art Unit: 3711

Applicant indicates in his specification that the "thickness sufficient" to perform the various claimed vision-interference functions is "one quarter inch or more". (see page 4 of specification). From the foregoing, Arnold teaches a patch having the same thickness as Applicant's device (i.e. one quarter inch or more). Because the patch thickness disclosed by Arnold may be the same as disclosed by applicant, it is reasonable to consider Arnold's eye patch as inherently capable of performing applicant's vision-interference functions recited in claims 1 and 10.

While claim 1 refers to positioning the device on an individual's face generally, claim 10 recites that the vision-training device is placed specifically on the cheeks under the eyes of the individual. However, the recitation in claim 10 that the device is placed on the cheeks is considered to be an intended use of the device. With device claims, we are concerned with the structure and functional capability of the device, not how the device is used. See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Arnold's patch reasonably appears to be capable of being applied, via its adhesive, on a cheek under an eye of the user. The patch, so positioned, would inherently interfere with the user's vision as claimed since the patch has the same thickness and would be at the same location as applicant's claimed device.

Regarding claims 2 and 15, Arnold's patch, as explained above, has the same thickness as claimed. While the positioning of the patch is considered to be an intended use, nevertheless, Arnold's patch is capable of being positioned on the face of a user such that the maximum disclosed thickness reasonably appears to be inherently capable of directing a user's vision up and toward a field of play and players thereon (claim 2), or restricting the user's peripheral vision (claim 15). Also, Arnold teaches that the patch is disposable (claim 9). (see column 1, line 7).

Art Unit: 3711

Regarding claims 7 and 8, Generally, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the substrate, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) ; In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (C.C.P.A. 1969); MPEP § 2112.01 (Rev. 3, August 2005). Additionally, matters directed to design or ornamentation only, having no mechanical function whatsoever with respect to the claimed invention, cannot be relied on as a basis for patentability. In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (C.C.P.A. 1947). Therefore, in order for the "logo" and "written indicia" recited in claims 7 and 8 to distinguish the product from the prior art, there must be a functional relationship between the "logo" or "written indicia" and the substrate of the sports vision-training device. Mere ornamentation of the product will not impart patentability to an otherwise old product. Applying this legal principle to claims 7 and 8, it appears that the "logo" and "written indicia" limitations are mere ornamentation and are not functionally related to the substrate. Applicant has disclosed nothing in his specification to indicate that the "logo" or "written indicia" serves any function other than ornamentation. As such, the "logo" and "written indicia" may not be relied upon for patentability.

Regarding claim 18, because the patch thickness disclosed by Arnold may be the same as disclosed by applicant, it is reasonable to consider Arnold's eye patch as inherently capable of performing applicant's vision-interference functions. Therefore, during normal use and operation of the Arnold device, the method steps set forth by applicant in the claim is inherently provided.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-6, 11-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6,320,094) in view of Morgan et al (4,951,658).

Regarding claims 3, 11 and 16 the aforementioned claims require that the device be constructed of an open-cell foam material. Arnold teaches that the patch is made of a "biocompatible foamed plastic material", but is silent as to the foam being open-cell. (see column 2, line 15). Morgan teaches that making an eye patch out of open-cell foam material permits moisture from perspiration and wound exudate to evaporate through sides of the foam material. (see column 2, lines 36-39). Moreover, Morgan teaches that the open cell foam material increases comfort of the user and does not cause trauma to skin (i.e. skin rash). (see column 5, lines 24 and 25; and column 3, lines 15, 16 and 21). Seemingly, it would have been prima facie obvious at the time the invention was made, to a person of ordinary skill in the art, to have combined Morgan's open-cell foam material with Arnold's biocompatible foam eye patch in view of Morgan's express teachings as to the enhanced comfort and breathability of a patch made of open-cell foam.

Regarding claims 4, 5, 13 and 17, the aforementioned claims are all directed to using an adhesive that absorbs moisture and transfers it from the individual's skin to the device so as to evaporate the moisture. Claims 4, 5, 13 and 17 require a hydrocolloid as the moisture absorbing

Art Unit: 3711

material. Arnold teaches using an adhesive to attach her patch to the user. (see column 3, lines 34-39). Morgan's hydrocolloidal adhesive wicks moisture from the user's skin through the adhesive and to the open cell foam patch for evaporation therefrom. (see column 2, lines 29-39). Moreover, Morgan teaches that using such a hydrocolloidal adhesive prevents the adhesive from being weakened by sweat or other moisture and, thereby, increases the comfort of the user. (see column 4, lines 32-38, column 5, lines 24 and 25). Seemingly, it would have been prima facie obvious at the time the invention was made, to a person of ordinary skill in the art, to have used Morgan's hydrocolloidal adhesive material as the adhesive for Arnold's adhesively attached eye patch in order to increase the comfort of the user and permit the patch to adhere better to the individual's skin as taught by Morgan.

Regarding claim 6, Arnold further shows the piece of material (i.e. patch) includes a narrow stem at the base of the adhesive (best seen in figures 3 and 5; the first sheet 11 includes recessed peripheral portions above the peripheral portions 13A of the adhesive layer 13).

Regarding claim 12, the adhesive claimed does not require the ability to transfer moisture. As such, Arnold, alone, would teach the feature of claim 12, because Arnold teaches using an adhesive to attach the eye patch to the face of the individual. (Column 3, lines 34-39).

Regarding claim 14, note the rejection of claim 6.

### ***Conclusion***

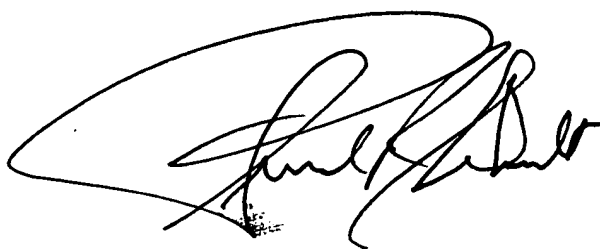
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 10:00 to 6:00.

Art Unit: 3711

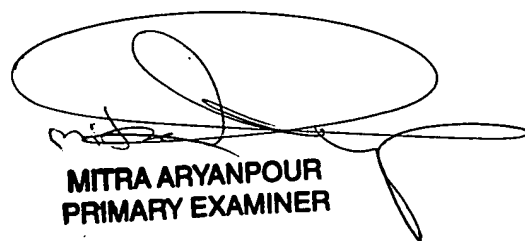
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

21 September 2006



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PRIMARY EXAMINER